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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 09/621,946  | 07/24/2000  | Venkatachari Dilip   | CE1-001US                 | 5253             |
| 29150   | 7590        | 11/03/2006           | EXAMINER                  |                  |
| LEE & HAYES, PLLC<br>421 W. RIVERSIDE AVE, STE 500<br>SPOKANE, WA 99201 |             |                      | SUBRAMANIAN, NARAYANSWAMY |                  |
|   |             |                      | ART UNIT                  | PAPER NUMBER     |
|   |             |                      | 3692                      |                  |

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/621,946

Applicant(s)

DILIP ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 59-67, 71 and 78-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-67, 71 and 78-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to applicants' communication filed on August 18, 2006. Amendments to claims 59 have been entered. Claims 59-67, 71 and 78-82 are pending in the application and have been examined. The objections to the specification, rejections and response to arguments are stated below.

#### *Specification*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. *Vas-Cat, Inc. v. Mahurkar*, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

Claims 59-67, 71 and 78-82 include the limitation “the financial management system obtains account information from the first and second accounts based on information provided by an account holder without any permission of the first or second financial institution and without any pre-arranged data exchange agreement with the first or second financial institution”. However, the specification does not provide a written description disclosure to support the

Art Unit: 3692

claimed limitation of “the financial management system obtains account information from the first and second accounts based on information provided by an account holder without any permission of the first or second financial institution and without any pre-arranged data exchange agreement with the first or second financial institution”.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 59-67, 71 and 78-82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 59-67, 71 and 78-82 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

For the art rejections given below, the claims are interpreted in light of 35 U.S.C. § 112, first paragraph rejections discussed above.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 71 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 59 is a method claim. Claim 71, which is dependent on claim 59, is directed to one or more computer readable memories. It is not clear as to which statutory class claim 71 belongs. Appropriate clarification/correction is required. One way to overcome this rejection is to write the claim in independent form.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 59-67, 71 and 78-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musmanno (US Patent 4,346,442) in view of Frank et al (US Patent 6,240,399 B1).

Claim 59, Musmanno discloses a method comprising: a processor-based financial management system identifying a first account balance associated with a first account See Musmanno Column 8 lines 29-36), wherein the first account is associated with a first financial institution (See Musmanno claim 1 and Applicant's own background disclosure Page 3 lines 1-7); the financial management system further identifying a second account balance associated with a second account, wherein the second account is associated with a second financial institution, the second financial institution being independent of the first financial institution (See Musmanno Claim 1, brokerage account data contains information about the balances also); the financial management system comparing the first account balance to a particular value (See Musmanno Figure 3); and if the first account balance exceeds the particular value, the financial

Art Unit: 3692

management system recommending a transfer of funds from the first account to the second account associated with the second financial institution, wherein the first account and the second account have a common account holder, and wherein the recommendation to transfer funds identifies an amount to be transferred equal to the value by which the first account balance exceeds the particular value (See Musmanno Column 2 lines 55-58, Column 7 line 61 - Column 9 line 67); and if the first account balance is below the particular value, the financial management system recommending a transfer of funds from the second account to the first account (See Musmanno Figure 3 and Column 7 line 61 - Column 9 line 67).

Musmanno does not explicitly teach the step wherein the financial management system obtains account information from the first and second accounts based on information provided by an account holder. However the limitation “wherein the financial management system obtains account information from the first and second accounts based on information provided by an account holder” is not a positive recitation of the obtaining step and hence not given patentable weight.

Frank teaches the step wherein the financial management system obtains account information from the first and second accounts based on information provided by an account holder (See Frank Column 7 lines 23-32)

Both Frank and Musmanno are concerned with the problem of allocating the financial assets of clients so as to maximize their return. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Musmanno to include the teachings of Frank. The combination of the teachings suggests that clients would have benefited from the ongoing

monitoring of the portfolio of accounts after the initial allocation is made (See Frank Column 4 lines 41-45).

Claims 60-67, 71 and 78-82, Musmanno discloses the steps wherein comparing the first account balance to a particular value is performed at periodic intervals (See Musmanno Column 1 lines 33-37); comparing the first account balance to a particular value includes applying at least one rule associated with the first account (See Musmanno Figures IB, 2 and 3); wherein the first account is a checking account (See Musmanno claim 1) and the second account is a savings account (See Musmanno claim 1, money market account is a form of savings account); wherein the second account pays a higher interest rate than the first account (inherent in the disclosure); if the first account balance is below the particular value, the financial management system recommending a transfer of funds from the second account to the first account in an amount equal to the value by which the first account balance is below the particular value (See Musmanno Column 7 line 61 - Column 9 line 67); offering to perform the recommended transfer of funds from the first account to the second account and executing the transfer of funds from the first account to the second account if the account holder accepts the offer to perform the recommended transfer of funds (inherent in the disclosure, manual buying/selling implies this feature); recommending a transfer of funds from the first account to the second account includes automatically transferring funds from the first account to the second account (See Musmanno Column 9 lines 27-45 and claim 6); one or more computer-readable memories containing a computer program that is executable by a processor to perform the method recited in claim 59 (inherent in the disclosure); wherein the first account is a checking account and the second account is an investment account (See Musmanno claim 1, money market account is a form of

investment account); wherein the second account offers a better return than the first account (inherent in the disclosure); wherein the particular value is a minimum balance associated with the first account (old and well known); wherein the particular value is a minimum required balance based on historical data (See Musmanno Column 4 lines 41-45, various purposes is interpreted to include this feature); and permitting the account holder to change the amount to be transferred from the first account to the second account (See Musmanno Column 9 lines 50-67, manually entered commands include this feature).

### ***Response to Arguments***

10. In response to Applicant's arguments that "Although Musmanno discloses the movement of funds from a bank to a brokerage house, the reference does not disclose or suggest the bidirectional movement of funds described in claim 59 based on comparison of account balances with a particular value", the examiner respectfully disagrees. Musmanno in Column 2 lines 45 - 67, clearly discloses flow of funds from the brokerage house to the bank account based on comparison of account balances with a particular value. Hence Musmanno clearly discloses the movement of funds from a bank to a brokerage house and vice versa.

Applicant's other arguments with respect to pending claims 59-67, 71 and 78-82 have been considered but are not persuasive in view of the 35 U.S.C. § 112, first paragraph rejections above.

### ***Conclusion***

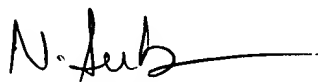
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dr. N. Subramanian  
Primary Examiner

Application/Control Number: 09/621,946  
Art Unit: 3692

Page 9

October 27, 2006